

### **III. REMARKS**

In response to the Examiner's rejection of claims 39-54 under 35 USC § 101 ("double-patenting") as claiming the same invention of particular claims of U.S. Patent No. 6,208,273 and co-pending application number 09/491,343, Applicants have cancelled claims 39-40, 42-44, and 46-54. However, Applicants have not cancelled claims 41 and 45. Applicants submit that claims 41 and 45, respectively, do not claim the same invention as claims 84 and 100 of U.S. Patent No. 6, 208,273. In particular, claims 41 and 45 are worded differently from claims 84 and 100, and accordingly Applicants respectively request that the Examiner withdraw the double-patenting rejection of these claims. Please note that since claims 41 and 45 are dependent claims, Applicants have amended claims 41 and 45 herein to include the elements of their respective independent claims.

Claims 55, 57, 60, and 61 were provisionally rejected under the judicially created doctrine of obviousness-type double-patenting as being unpatentable over claims 111 and 112 of co-pending application number 09/491,343. Furthermore, claims 17-33 were rejected under the judicially created doctrine of obviousness-type double-patenting as being unpatentable over claims 9-24 of U.S. Patent No. 6,208,273. In rejecting claims 17-33 for obviousness-type double-patenting, the Examiner also referenced the Yabe et al. article entitled "Compression/Decompression DRAM for Unified Memory Systems: a 16Mb, 20MHz, 90% to 50% Graphics-Bandwidth Reduction Prototype" (hereinafter referred to as the "Yabe article"). Applicants assume that the reference to the Yabe article was inadvertent. In response to the rejection of these claims for obviousness-type double-patenting, Applicants submit herewith Terminal Disclaimers. Please note that the present application, co-pending application number 09/491,343, and U.S. Patent No. 6,208,273 were all assigned from Interactive Silicon, Inc. to Austin IP Acquisition, Inc., which subsequently changed its name to Quickshift, Inc. The appropriate documentation reflecting such assignments and the name change are being recorded concurrently herewith, but in a separate filing. A copy of the documents being recorded are submitted herewith.

The Examiner rejected claims 1 and 17 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim that subject matter which Applicants regard as the invention. In response to this rejection, Applicants have amended these claims to more particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Please also note that claim 19 was amended to fix a typographical error.

Claims 34-37 were rejected under 35 USC § 102(b) as being anticipated by the Yabe article. Furthermore, claims 17-28, 30, 35, 55, 56, 58, and 59 were rejected under 35 USC § 103(a) as being unpatentable over the Yabe article in view of U.S. Patent No. 5,771,011. Applicants respectfully traverse the rejection of claims 34-37 on the basis that the Yabe article is not prior art to those claims. In particular, the Yabe article has a publication date of February 5-7, 1998. At least claims 34-37 of the present application are supported, however, by disclosure in related applications and patents having a priority date much earlier than 1998. In particular, as reflected in the "Continuation Data" section of the present application, this application is a continuation-in-part of U.S. Application Serial No. 09/239,659, which was filed January 29, 1999. U.S. Patent Application Serial No. 09/239,659 is a continuation-in-part application of U.S. Patent Application Serial No. 08/916,464, now U.S. Patent No. 6,173,381, which was filed August 8, 1997. Applicants have amended the Continuation Data section to reflect the relationship between U.S. Patent Application Serial No. 09/239,659 and U.S. Patent No. 6,173,381.

With regard to claims 17-28, 30, 35, 55, 56, 58, and 59, Applicants submit that these claims are allowable over U.S. Patent No. 5,771,011 to Masenas for at least the same reasons that the claims of U.S. Patent No. 6,208,371 were allowed over Masenas. Masenas was cited by the Examiner during the prosecution of U.S. Patent No. 6,208,371, but nonetheless the claims were allowed over this reference. Furthermore, in the Examiner's Office Action to the present application, the Examiner submitted that claims 17-33 of the present application are not patentably distinct over claims 9-24 of

U.S. Patent No. 6,208,273. If those present claims are not patentably distinct from the cited claims in U.S. Patent No. 6,208,273, and the claims of U.S. Patent No. 6,208,273 were allowed over the Masenas patent, then claims 17-28, and 30 of the present application should be allowed for at least the same reasons. Applicants further submit that claims 35, 55, 56, 58, and 59 should also be allowed for at least the same reasons. Alternatively, Applicants respectfully request the Examiner to explain why claims 35, 55, 56, 58, and 59 should be treated any differently than claims 17-28, and 30.

Applicants appreciate the Examiner's indication that the Information Disclosure Statements of February 22, 2001 and June 11, 2003 were considered. However, Applicants have not received an initialed copy of the PTO 1449 for the June 11, 2003 Information Disclosure Statement, and respectfully request return of an initialed copy. Another copy of the PTO 1449 is attached for the Examiner's convenience. Please also note that Applicants have submitted herewith another Information Disclosure Statement which cites the references from co-pending application Serial No. 09/491,343.

#### IV. CONCLUSION

In view of the remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, Examiner is requested to telephone the undersigned at (512) 370-2858.

Respectfully submitted,



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#### CERTIFICATION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450, on December 15, 2003.



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